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09/832,440	04/11/2001	Steve Morsa		7403
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OUELLETTE, JONATHAN P				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/832,440

**Applicant(s)**

MORSA, STEVE

**Examiner**

Jonathan Ouellette

**Art Unit**

3629

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 181-269, 271 and 272 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 269 is/are allowed.
- 6) ☒ Claim(s) 181, 183, 184, 186-203, 205, 206, 208-225, 227, 228, 230-247, 249, 250, 252-268, 271, and 272 is/are rejected.
- 7) ☒ Claim(s) 182, 185, 204, 207, 226, 229, 248 and 251 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on **2/26/2010**, PROSECUTION IS HEREBY REOPENED. *New grounds of rejection* are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629

### ***Response to Amendment***

2. Claim 270 has been cancelled; therefore, Claims 181-269 and 271-272 are now pending in application 09/832,440.

*Specification*

3. The amendment filed 5/22/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. **The Applicant has deleted portions (employment originally indicated as a benefit) of the specification, which would change the scope of the originally filed application.**
4. Applicant is required to cancel the new matter in the reply to this Office Action.

**Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. **Claims 271-272 are rejected under 35 U.S.C. 102(a) as being anticipated by PMA (“Peter Martin Releases HelpWorks Web Edition,” Business Wire, September 28, 1999).**
7. As per **independent Claims 271-272**, PMA discloses a method/apparatus of generating a benefit result list in real or substantially real time (web-based self-service model) in response to a benefit match request from a benefit seeker using a computer network, comprising maintaining at least one database stored in and/or on an article of manufacture including a plurality of benefit listings (eligibility library / Expert Eligibility Server); receiving a benefit match request transmitted from an article of manufacture from said seeker, said request

including said seekers criteria (Criteria Questions answered and inputted into system); identifying using a processing device those of said benefit listings having criteria which generate a match with said match request; generating automatically a message to a receiving article of manufacture to inform said seeker via said computer network of those of said benefits which match said seekers criteria (Users screen themselves).

### **Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. **Claims 181, 184, 188-203, 206, 210-225, 228, 232-247, 250, and 254-268 are rejected under 35 U.S.C. 103(a) as being unpatentable over PMA (“Peter Martin Releases HelpWorks Web Edition,” Business Wire, September 28, 1999).**
10. As per **independent Claims 181, 203, 225, and 247**, PMA discloses a system [method, computer-readable code, mechanism] comprising: storing in physical memory device benefit information, benefit provider information, and benefit correlation information (Expert Eligibility Server, eligibility library); said processing device analyzing said individuals data, said benefit provider information, and/or said benefit correlation information to determine whether any benefit providers are offering any benefits applicable to said individual data (Eligibility Screening); generating a message to at least one receiving device to inform said

individual, at least in part via a computer compatible network, of any benefits applicable to said individuals data (Web enabled self-service module).

11. PMA fails to expressly disclose inputting at least a sub-set of an individual demographic, geographic, and/or psychographic data into a processing device by means of at least one data entry device in electronic communication with the processing device.
12. However, PMA does disclose that the HelpWorks eligibility *screening tool is configurable* to evaluate any or all benefits and or programs required, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the tool to include a multitude of available input criteria to match with the benefit programs in the eligibility library, for the purpose of increasing the system's accuracy in matching results.
13. As per Claims 184, 206, 228, and 250, PMA discloses storage of at least a portion of said individual's data (inherent to internet operations – Expert Eligibility Server).
14. As per Claims 188, 210, 232, and 254, PMA fails to expressly disclose requiring said individual to update said individuals data as a condition of said individual continuing to remain a system user.
15. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to require up-to-date information from a user, in order to provide valid results; and a real-time system would obviously require continual maintenance from users to ensure up-to-date data.
16. As per Claims 189, 211, 233, and 255, PMA fails to expressly disclose said individual and or at least one of said benefit providers to pay for said system access and use from at least one from the group of: on a per benefit disclosed basis; on a per benefit received basis;

on a per benefit utilized basis; through said individuals relinquishment of at least a portion of at least one of said benefits; through the cash or cash equivalent payment of some part or percentage of the value of at least one of said benefits.

17. However, the article describing the HelpWorks system, does suggest that the system is to be provided by Peter Martin Associates to the public, and Official Notice is taken that charging for services provided to users was a well-known form of business at the time the invention was made. Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to charge for the services provided by PMA.
18. As per Claims 190, 212, 234, and 256, PMA discloses receiving directly and or via one or more third party intermediaries of monetary revenue and or other value from at least one benefit provider (PMA Commerce – See rejection of Claims 189, 211, 233, and 255).
19. As per Claims 191, 213, 235, and 257, PMA discloses one or more from the group of: updating benefits data; modifying benefits data; removing benefits data; adding new benefits data (user configurable).
20. As per Claims 192, 214, 236, and 258, PMA discloses said message to: reveal one or more of said benefits not applicable to individual; provide one or more of said benefit providers not applicable; provide one or more of said benefit providers benefit application forms; provide one or more of said benefit providers contact information; provide a map for and or direction to one or more of said benefit providers (HelpWorks system is meant to be a screening an *referral* tool).
21. As per Claims 193, 215, 237, and 259, PMA discloses at least one from the group of: *connecting said individual with at least one of said plurality of benefit providers*; said

individual to interact with at least one of said benefits to said individual; completion of one or more application forms, when applicable, by said individual; assisting transmitting at least one benefit approval for said individual by at least one of said benefit providers; transmitting an acceptance of at least one of said benefits by said individual; receiving at least one of said benefits by said individual; utilizing at least one of said benefits by said individual (HelpWorks system is meant to be a screening an *referral* tool).

22. As per Claims 194, 216, 238, and 260, PMA discloses performing at least one of the listed means for in real or near real time (Web-based system).
23. As per Claims 195, 217, 239, and 261, PMA discloses wherein said individual benefits or benefits information is shared with at least one other entity via said system (Provide user results in caseworker example).
24. As per Claims 196, 218, 240, and 262, PMA discloses wherein said message includes at least one benefit for which said individual: *may qualify for*; and or may not qualify for; and or does qualify for; and or does not qualify for (Pg.1).
25. As per Claims 197, 219, 241, and 263, PMA fails to expressly disclose discloses wherein said message informs individual of at least one benefit contained within said memory without regards to at least some part of said individual's data.
26. However, PMA does disclose that the HelpWorks eligibility *screening tool is configurable* to evaluate any or all benefits and or programs required, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the tool to include benefits that matched all entered criteria as a general baseline or to offer basic results to all users.



27. As per Claims 198, 220, 242, and 264, PMA discloses wherein one or more of said benefit providers submit said benefit information and or said benefits directly into said system (User configurable).
28. As per Claims 199, 221, 243, and 265, PMA discloses wherein at least one of said benefit information and or said benefits from at least one of said benefit providers is delivered directly into said system via at least one third party intermediary acting on behalf of at least one of said benefit providers (PMA configured presets – government benefits).
29. As per Claims 200, 222, 244, and 266, PMA fails to expressly disclose wherein said available benefits vary according to: the amount of said individual's data; and or the completeness of said individual's data.
30. However, PMA does disclose an eligibility-screening tool based on entered criteria, and the amount of criteria entered would obviously equate to varying amounts of system matches (well known function of database correlation systems).
31. As per Claims 201, 223, 245, and 267, PMA fails to expressly disclose wherein at least a partial set of phantom individual's data is inputted; wherein said phantom data does not belong to nor correspond to said individuals actual factual data.
32. However, the phantom data, as claimed above, is simply a user decision to experiment with data inputs to investigate available options, and it would have been obvious to users at the time the invention was made to complete trial and error techniques with the system to investigate the best-fit options available to them.
33. As per Claims 202, 224, 246, and 268, PMA fails to expressly disclose wherein said individuals data includes said individuals identification information.

34. However, PMA does disclose wherein the system can be used as a self-service model; therefore, the user would have to include some sort of identification (e-mail, web-connection ID) in order to receive results from the system.
35. Furthermore, PMA discloses wherein the system is used by caseworkers, who would obviously require a user ID to identify/separate specific case evaluations.

*Allowable Subject Matter*

36. **Claim 269 is allowed**
37. As per Claim 269, the prior art fails to expressly teach or disclose wherein said requester thereafter receives, utilizing said stored request and via a data receiving device, at least one automatically generated updated subset of said benefit information.
38. **Claims 182, 185, 204, 207, 226, 229, 248, and 251 are considered allowable** if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
39. As per Claims 182, 204, 226, and 248, the prior art fails to expressly teach or suggest means for the display of said benefits to said individual in a manner selected from the group consisting of benefit class or category; value of benefits; cost, if any, of benefits; importance of benefits; relevance of benefits; ease of use of benefits; expiration date, day, time of benefits; creation date, day, time of benefits; types of benefits; physical proximity of said individual to one or more of said benefit providers.
40. Claims 183, 205, 227, and 249 are considered allowable as they depend directly on allowable claims.

41. As per Claims 185, 207, 229, and 251, the prior art fails to expressly teach or suggest means for updating the status and or availability of benefits for said individual as: at least one of said benefit providers intends to or actually does modify the existing benefit qualification parameters for one or more of said providers benefits; and or at least one of said benefit providers intends to or actually does modify or eliminate an existing benefit, or offers one or more benefits not previously offered; and or one or more individual applicable benefits offered by one or more benefit providers new to, or returning to, said system are added to said system.
42. Claims 186, 208, 230, and 252, are considered allowable as they depend directly on allowable claims.
43. Claims 187, 209, 231, and 253 are considered allowable as they depend directly on allowable claims.

***Response to Arguments***

44. Applicant's past arguments with respect to Claims 181, 184, 188-203, 206, 210-225, 228, 232-247, 250, 254-268, 270-272, have been considered but are not found to be persuasive. The rejection will remain as NON-FINAL, based on the cited prior art.
45. The Applicant has made the argument that the cited prior art of PMA (9/28/99, press release), is not valid prior art because an additional press release was issued regarding similar subject matter on 4/24/2001. However, the Examiner believes the press release issued on 9/28/99 is valid and is similar but different from the press release issued on 4/24/2001. The arguments made by the Applicant regarding the validity of the cited prior art hold no proof

that the original press release (9/28/99) was improper and are merely speculative comments.

The Examiner also believes that the original press release (9/28/99) contained sufficient subject matter, which would enable one of ordinary skill in the art at the time the invention was made to recreate the business method/system.

46. As per independent claims 270-272, the Applicant has made argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., more than human benefit-matching, multiple types of benefits, multiple supported agencies, privacy disclosure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
47. As per independent claims 181, 203, 225, and 247 the applicant has made the argument that the cited prior art only covers a small portion of the claimed subject matter.
48. However, PMA teaches the subject matter as broadly claimed by the applicant. For example independent claim 181 discloses matching benefits from benefit providers to individuals eligible to receive benefits, which is clearly covered by the cited prior art of PMA.
49. PMA discloses a method/system for offering benefits from a wide variety of benefit providers to a wide variety of "consumers." The Examiner believes that the language used by the prior art for method/system users is equivalent to the stated users indicated by the Applicant.

50. Further, the Applicant is requested to better indicate in future responses the exact claim and subject matter, in which the Applicant believes the cited prior art fails to teach or suggest.
51. Finally the applicant has made the argument that the cited prior art fails to teach several elements taught by the dependent claims.
52. However, the last Non-Final office action was issued (1/18/2007) to incorporate a 103(a) rejection in order to explain the obviousness of the claimed subject matter contained in the dependent claims in comparison to the cited prior art of PMA and Official Notice. Therefore, the Applicant is directed to the rejection above for answers to arguments.

### *Conclusion*

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
54. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
55. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

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July 19, 2010

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629